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| 09/693,019 | 10/20/2000 | Shinichi Baba | 1204-US | 7461 |

9941 7590 03/21/2005

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| EXAMINER |
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KADING, JOSHUA A

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| ART UNIT | PAPER NUMBER |
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2661

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,019

Applicant(s)

BABA ET AL.

Examiner

Joshua Kading

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5,8-10,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5,8-10,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 4,5,9,13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed 20 September 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In the amended specification, page 10, beginning on line 18, "The SIP-EYE Agent thus comprises a computer readable medium having...with the mobile station, when necessary;" page 17, beginning on line 21 the insertion of the word "software", "creates required data structures for these connection, and stores them with the mobile station;" page 27, line 1 the insertion of "sends a SIP request containing an," "request message containing an," the change of "message" to "method," and "and the body of the INFO method contains the instruction for binding the previous IP address of the mobile station with the current IP address...the mobile station with its new one."

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. Page 1 of the specification contains the referenced hyper link, specifically regarding the SIP INFO method. It should be noted that the same SIP INFO method document referenced by the hyperlink

should still be referenced; it just cannot be through the use of the hyperlink. See MPEP § 608.01.

Claim Objections

5 Claims 4, 5, 9, 13, and 14 are objected to because of the following informalities:

Claim 4, line 1 and claim 13, line 2 state, “net work”, i.e. it appears the word “network” is actually split into two words “net” and “work”. This should be changed to one word, --network--.

Claim 5, line 2 the word "sad" should be changed to --said--.

10 Claim 4, lines 5-6; claim 9, lines 6-7; and claim 14, lines 7-8 the words “the .
CONTACT field” and “the SIP REGISTER” should be changed to --a CONTACT field--
and --a SIP REGISTER-- respectively.

Appropriate correction is required.

15 ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20 Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, it is unclear if applicant intends the claim to be directed to a set of “executable instructions” contained on “a computer readable medium” as in lines

4-5, or if the claim is meant to be directed towards an apparatus style claim as indicated by the last line of the preamble, "each data structure having associated therewith..."

Clarification is required.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15

Claims 2, 4, 8, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,697,354 B1, Borella et al. (Borella) in view of U.S. Patent 6,266,405 B1, Madour et al. (Madour) and in further view of applicant's admitted prior art (AAPA).

20

Regarding claims 2, 8, and 13, Borella discloses, "a system for forwarding transient data packets addressed to a mobile station from a corresponding host node in a first...network environment, said mobile station having traveled from said first...network environment to a second...network environment (col. 18, lines 61-col. 19, lines 1-2), said system comprising: a computer readable medium having executable instructions to (col. 2, lines 56-62): reinvoke said corresponding host node to said mobile station...said mobile node being in said second...network environment (col. 19, lines

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27-35); create a tunnel between a first edge router and controller located within said first...network environment and a second edge router and controller located within said second...network environment by sending a...request message...from the second edge router and controller to the first edge router and controller (col. 19, lines 7-8 and col. 20, lines 34-49 where the HA acts as an edge router); forward said transient data packets to said mobile station via said tunnel (col. 20, lines 46-49); and discontinue said forwarding of said data packets to said mobile station after a time-out period (col. 22, lines 21-28 where keep-alive messages are intended to act as "time-out stoppers", i.e. they delay the time-out period by indicating the mobile is still connected and if the keep-alive messages stop, the time-out period will expire thus indicating the mobile is no longer attached and the network will logically stop sending data to the mobile)."

However, Borella lacks what Madour discloses, the first and second networks are SIP-compliant (figure 6, element 121 shows the use of a SIP network) and the reinviting is done through using SIP INVITE (figure 6 shows the signalling INVITE command).

It would have been obvious to one of ordinary skill in the art to use a SIP-compliant network and its methods for not only the purpose of design choice but also to incorporate additional options in the signalling (Madour, col. 6, lines 19-23). The motivation for adding additional options is to increase the features available to the user and network for established communications, for example, caller ID.

Borella and Madour however, lack what AAPA discloses, the request message is SIP that contains a SIP INFO method (specification, page 4, lines 7-9 where applicant

specifically acknowledges that the information contained in that section is prior art as cited, see page 1 of the specification).

It would have been obvious to one of ordinary skill in the art at the time of invention to include the SIP INFO method for the purpose of communicating important control information during a session. The motivation for doing this is so that the connection can be maintained.

Regarding claims 4, 9, and 14, Borella discloses, "a system for reducing the amount of time a mobile station takes to register and configure itself in a visiting...network environment, comprising a computer readable medium having executable instructions to (col. 2, lines 56-62): equip a...register node with a DHCP client node and co locating said...registrar node with a DHCP server node to enable said...registrar node to assign an IP address to said mobile station thereby reducing acquisition time (col. 22, lines 41-45 where the roaming node registers with the visiting networks gateway router and is assigned an IP address which is then communicated to the home network and as read, the registering and assigning are all done within the gateway router; it should be noted that gateway router functions equivalently to a DHCP server (and therefore all nodes under it are also DHCP nodes) by dynamically assigning IP addresses to various nodes connecting and disconnecting to its network)."

However, Borella lacks what Madour discloses, the visiting network is SIP-compliant (figure 6, element 121 shows the use of a SIP network), the register node is SIP (figure 6 where if the network is SIP-compliant then the nodes are SIP).

It would have been obvious to one of ordinary skill in the art to use a SIP-compliant network for not only the purpose of design choice but also to incorporate additional options in the signalling (Madour, col. 6, lines 19-23). The motivation for adding additional options is to increase the features available to the user and network for established communications, for example, caller ID.

Borella and Madour however, lack what AAPA discloses, designating "an additional option for the CONTACT field of the SIP REGISTER method, which option indicates registration or hand-off (specification, page 2, lines 5-9 where it is indicated that the CONTACT field is specifically used for registration information)."

It would have been obvious to one of ordinary skill in the art at the time of invention to include the CONTACT field for registration for the purpose of registering newly connected or disconnected nodes. The motivation for doing this is to keep the overall state of the network up to date.

Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borella, Madour, and AAPA as applied to claims 4 and 9 above, and further in view of U.S. Patent 6,539,237 B1, Sayers et al. (Sayers).

Regarding claims 5 and 10, Borella, Madour, and AAPA disclose the method of claim 4 and the computer program of claim 9. However, Borella, Madour, and AAPA lack what Sayers discloses, "replicating a profile of said mobile station in said visiting environment to reduce said authentication time of said mobile station (col. 13, lines 1-4)." It would have been obvious to one of ordinary skill in the art to store user data in a

local database for the purpose of having access to the data quickly (Sayers, col. 13, lines 5-8). The motivation for accessing data quickly is to not waste time which is especially important in a real-time environment like mobile communication.

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Allowable Subject Matter

Claim 3 would be allowable (for reasons previously indicated) if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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Response to Arguments

Applicant's arguments filed 20 September 2004 have been fully considered but they are not persuasive. Regarding applicant's arguments about the added material to the specification, applicant cannot add new matter to the specification for any reason as indicated above. However, if applicant feels certain aspects of the invention require further explanation, the applicant response is the appropriate place for them.


Further, applicant is reminded that although an updated version of an originally cross referenced piece of material has been published, this newly updated version cannot replace the originally cross referenced publication without adding new matter. Therefore, the updated version cannot be added to the specification. However, the applicant may submit any materials for consideration in an IDS pursuant to 37 CFR 1.97 and 37 CFR 1.98.

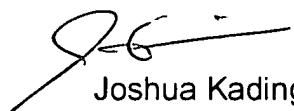
Applicant's arguments, see REMARKS, pages 9-10, filed 20 September 2004, with respect to the 35 U.S.C. 112, second paragraph rejections of claims 2-4, 8-10, and 12-15 have been fully considered and are persuasive. The 35 U.S.C. 112, second paragraph rejections of claims 2-4, 8-10, and 12-15 have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art and a better understanding of applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BOB PHUNKULH
PRIMARY EXAMINER


Joshua Kading
Examiner
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